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| 09/747,824      | 12/22/2000  | John Simons          | 16869c017000        | 4283             |

7590 02/10/2004

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EXAMINER

NAHAR, QAMRUN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2124

DATE MAILED: 02/10/2004

# 6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/747,824

Applicant(s)

SIMONS, JOHN

Examiner

Qamrun Nahar

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Requirement for Information*.

### **DETAILED ACTION**

1. This action is in response to the preliminary amendment filed on 10/17/01.
2. Claims 1 and 2 have been amended.
3. Claims 3-8 have been added.
4. Claims 1-8 are pending and have been examined.

### ***Information Disclosure Statement***

5. The information disclosure statement filed on 2/26/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it is not a proper IDS or Affidavit. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Drawings***

6. The drawings filed on 4/5/01 are accepted.

### ***Specification***

7. Preliminary amendment to the specification filed on 10/17/01 has been entered.

***Claim Objections***

8. Claim 2 is objected to because of the following informalities: "each the instructions" on line 4 of the claim should be "each of the instructions". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the first and second instructions" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "the first instructions and the second instruction".

Claim 4 also recites the limitation "the include statement corresponding to the second statement" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "the predetermined statement corresponding to the second instruction".

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) he has abandoned the invention.

12. Claims 1-8 are rejected under 35 U.S.C. 102(c) because the invention has been abandoned.

The Information Disclosure Statement filed on 2/26/02 indicated that the present invention, also known as "Spoof assembler", has been in existence "In or about 1994" and has been in use internally to test the new processor and/or other software products.

The Information Disclosure Statement shows lack of diligence to the present invention since the present invention was fully functional since 1994 and no testing and/or improvements have been made to the present invention.

In order to overcome this rejection, please provide the title, citation and copy of each documentation and/or publication, which describe testing and/or improvements of the disclosed subject matter of "**Spoof assembler**" between the year 1994 and 2000, if any; and please indicate which claims incorporate the improvements of the disclosed subject matter of "**Spoof assembler**", if any.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenbaum (U.S. 5,933,642).

**Per Claim 3:**

The Greenbaum patent discloses:

- **a method of compiling source code having a plurality of first instructions and a at least one second instruction with a compiler capable of deciphering the first instructions but not the second instruction** (“A compiling system and method for generating a sequence of program instructions for use in a dynamically reconfigurable processing unit having an internal hardware organization that is selectively changeable among a plurality of hardware architectures, each hardware architecture executing instructions from a corresponding instruction set. Source files are compiled for execution using various instruction set architectures as specified by reconfiguration directives.” in abstract and column 13, lines 23-27)
- **copying each of the first instructions to a temporary file** (column 13, lines 34-39)
- **converting the second instruction to an object code equivalent that forms an argument of a predetermined compiler statement that is written to the temporary file in place of the second instruction** (column 4, lines 33-37 and column 13, lines 40-50)
- **applying the temporary file to the compiler to convert each of the first instructions to object code equivalents that are written to an object file; and removing the argument of the predetermined statement to write the argument to the object file** (column 13, lines 51-66 and column 14, lines 29-37).

**Per Claim 4 (as best understood):**

The Greenbaum patent discloses:

- wherein the first instructions and the second instruction are in a predetermined order in the source code, and the predetermined order is maintained when the first instructions and the predetermined statement corresponding to the second instruction are in the temporary file (column 13, lines 23-54).

**Per Claim 5:**

The Greenbaum patent discloses:

- wherein the predetermined statement is a data directive (column 4, lines 24-32 and column 13, lines 40-50).

**Per Claim 1:**

This is another version of the claimed method discussed above (claims 3, 4 and 5), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Greenbaum.

Art Unit: 2124

**Per Claim 2:**

This is another version of the claimed method discussed above (claims 3 and 5), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Greenbaum.

**Per Claims 6-7:**

These are processing system versions of the claimed method discussed above (claims 3 and 5, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Greenbaum.

**Per Claim 8:**

This is a system version of the claimed method discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Greenbaum.

***Conclusion***

15. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.



Art Unit: 2124


16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

QN  
February 4, 2004



**TODD INGBERG**  
**PRIMARY EXAMINER**

***Requirement for Information – 37 CFR § 1.105***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The Assignee (Hitachi America, Ltd.) and inventor John Simons have indicated in the Information Disclosure Statement filed on 2/26/02 that the present invention, also known as “Spoof assembler”, has been in existence “In or about 1994” and has been in use internally to test the new processor and/or other software products.

This requirement is made with the intent to assist in the prosecution of this case. The Examiner feels the scope of this requirement is narrow and should be well within the abilities of the concerned parties to provide this information.

- a) In response to this requirement, please provide the title, citation and copy of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of **“Spoof assembler”**.
- b) In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.
- c) In response to this requirement, please provide the title, citation and copy of each user manual and/or programmer guide, which describe the disclosed subject matter of **“Spoof assembler”**.
- d) In response to this requirement, please provide the names and dates of first public use or sale of any products or services that are known to have incorporated the claimed subject matter.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

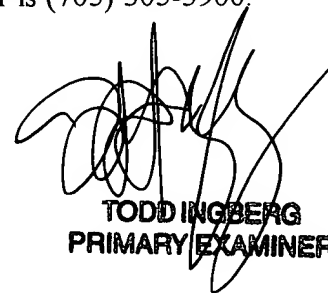
***Conclusion***

2. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

QN  
February 4, 2004



TODD INGBERG  
PRIMARY EXAMINER